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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,446	09/29/1999	HITOSHI TERASHIMA	64246RCE	2769
23872	7590	09/20/2007		
MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227			EXAMINER NGUYEN, MADELEINE ANH VINH	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 09/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/407,446

Applicant(s)

TERASHIMA ET AL.

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-39, 41, 45, 46, 48-52, 54, 56-65 and 67-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34-38 is/are allowed.
- 6) ☒ Claim(s) 39, 41, 45, 46, 48-52, 54, 56-58, 60-67 and 69-73 is/are rejected.
- 7) ☒ Claim(s) 59 and 68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 25, 2007 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 39, 41, 46, 48, 49-52, 54, 56-58, 60, 62-67, 69, 71-73 rejected under 35 U.S.C. 102(b) as being anticipated by Kotani (submitted Japanese reference no. JP 02100457).

Concerning claims 39, Kotani discloses an apparatus comprising an image forming apparatus (Figs.1, 2) comprising an image forming apparatus (2) and a scanner (4) which is removable mounted on the image forming apparatus (Fig.2) and includes a reading element (10), a motor (33) and a roller (11) driven by the motor; wherein the motor actuates the roller to transport a sheet with the scanner mounted on the image forming apparatus and the scanner reads

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an original guided by the roller driven by the motor with the scanner detached from the image forming apparatus, the scanner moving via the roller driven by the motor when the scanner is detached from the image forming apparatus; wherein a surface of said scanner on which said reading element is provided faces toward said image forming apparatus with said scanner mounted on said image forming apparatus to define a sheet transporting path between a surface of said image forming apparatus and said surface of said scanner (Figs.4-5; English translation on pages 1-2).

Concerning claims 41, 48, Kotani further teaches a printer (since the forming apparatus is a facsimile apparatus) and the scanner can be attached to and detached from the image forming apparatus (Figs.1-2).

Concerning claim 46, Kotani discloses a scanner as discussed in claim 39 above wherein a surface of the scanner on which the reading element is provided faces toward the image forming apparatus with the scanner mounted on the image forming apparatus to define a sheet transporting path between a surface of the image forming apparatus and the surface of the scanner (Figs.2-3).

Concerning claim 49, Kotani discloses a scanner as discussed in claim 39. The scanner further comprises a sheet accommodating part in the image forming apparatus for accommodating a plurality of sheets; a sheet being delivered from the sheet accommodating part by the roller with the scanner mounted on the image forming apparatus, and being read by the reading element while said roller is rotated in contact with a surface of said sheet which is read by said reading element with said scanner detached from said image forming apparatus, wherein said motor actuates said roller to transport a sheet with said scanner mounted on said image

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forming apparatus, and said scanner reads an original guided by said roller driven by said motor with said scanner detached from said image forming apparatus, said motor actuating said roller such that said scanner is driven via said roller when said scanner is detached from said image forming apparatus (Fig.4; In this manner ... the configuration is simplified).

Concerning claims 50-51, 63, 71, 72, Kotani further teaches that said roller of said scanner apparatus and a sheet reading surface of said reading element are provided at a same side of said scanner apparatus, and a surface of said scanner apparatus on which said roller and said sheet reading surface of said reading element are provided constitutes a part of a sheet guide guiding said sheet delivered from said sheet accommodating part in a case where said scanner is mounted on said image forming apparatus (Figs. 4, 12; pages 1-2); said roller of said scanner apparatus is a pick roller, and said apparatus has a sheet separating member faced to the pick roller of the scanner apparatus in a case where the scanner apparatus is mounted on the image forming apparatus (Fig.4).

Concerning claims 52, 54, 56, 60, 61, 65, 69, Kotani discloses an apparatus as discussed in claim 49 above. Kotani further teaches the motor actuates the roller such that the scanner moves autonomously on an original via the roller driven by the motor when the scanner is detached from the image forming apparatus (Fig.5; pages 1-2).

Concerning claims 57, 58, 67, Kotani further teaches that the sheet accommodating part accommodates the plurality of sheets in a substantially vertical direction (Fig.3); a surface of the scanner on which the reading element is provided faces to the base in a case where the scanner is mounted on the base so that a sheet transporting path is made between a surface of the image forming apparatus and the surface of the scanner (Figs.2, 4).

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Concerning claims 64, 73, Kotani further teaches that the base unit is an image forming apparatus (facsimile communication apparatus).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 45, 61 and 70 rejected under 35 U.S.C. 103(a) as being unpatentable over Kotani as applied to claims 39, 56 and 65 above, and further in view of Noda et al (US Patent No. 6,320,679)

Concerning claims 45, 61 and 70, Kotani fails to teach a projecting member for protecting the roller in a case where the scanner runs by itself. Noda et al discloses the prior art of a portable scanner (Fig.3) having a supporting shaft 21, which is rotatably supported by a bearing 22, for a sensor roller 7, and an auxiliary roller 20 for protecting the roller 7 in a case when the scanner moves to read an original image (col. 1, lines 16-50). It would have been obvious to one skilled in the art at the time the invention was made to combine the above teaching of Noda et al to the scanner in Kotani since both of them teaches a detached scanner, when scanning an original image, moves relative to a flat stationary document.

Allowable Subject Matter

6. Claims 34-38 are allowed.
7. Claims 59 and 68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: Claims 34-38 are allowable over the prior art of record because the Examiner found neither prior art cited in its entirety, nor based on the prior art, found any motivation to combine any of the said prior art which teaches an apparatus comprising a scanner removable mounted on an image forming apparatus wherein the motor in the scanner drives a roller to transport a sheet with the scanner mounted on the image forming apparatus, and the scanner moves via a roller driven by a motor and the scanner reads an original guided by the roller driven by the motor with the scanner detached from the image forming apparatus, a first sheet transporting path is formed substantially vertically to guide a sheet downward and a second sheet transporting path extending substantially vertically to guide a sheet downward on the second sheet transporting path and the first and second sheet transporting paths are arranged adjacent to each other.

8. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Conclusion

9. Claims 39, 41, 45, 46, 48, 49-52, 54, 56-58, 60-67, 69-73 are rejected.

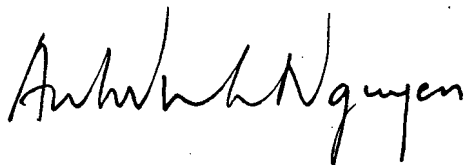
Claims 34-38 are allowed.

Claims 59 and 68 are objected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Madeleine AV Nguyen
Primary Examiner
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September 8, 2007